

## **REMARKS/ARGUMENTS**

In the Office Action mailed December 1, 2006, claims 1-9, 11-22 and 24-25 were rejected under 35 U.S.C. §102(b) as being anticipated by De La Huerga (US 2002/0084904 A1). Claims 11, 28 and 45 were rejected under 35 U.S.C. 103(a) as being unpatentable over De La Huerga. Claim 23 was also rejected under 35 U.S.C. 103(a) as being unpatentable over De La Huerga in view of Harilela (US 4,862,436).

Applicants acknowledge that the limitation requiring “one of said coupling elements has a predetermined area, and wherein the other said coupling elements has a length greater than the length of said one coupling element” is not supported by the disclosure of the parent application 10/101,219. Applicants further acknowledge that claims 1-9, 11-26, 28-43 and 45-55 are not entitled to the benefit of the filing date of the parent application 10/101,219 because of the inclusion of this limitation.

However it is the inclusion of this limitation which distinguishes the pending claims over the cited prior art. In rejecting claims 1-9, 11-22 and 24-55 as being anticipated by De La Huerga, the Office Action erroneously states that De La Huerga discloses that one of said coupling elements has a predetermined area and that the other said coupling elements has a length greater than the length of said one coupling element. There is no support in De La Huerga for the teachings alleged in the Office Action. In support of this alleged teaching, the Office Action cites to elements 106 and 108 in Fig. 2 as well as capacitive plates 358 and 360 in Fig. 34. The Office Action states that Fig. 34 shows that capacitive plate 358 has a length greater than capacitive plate 360 and both plates overlap each other. The Office Action goes on to state that L2 has a greater length than L1 as shown in Fig. 17.

Nothing in De La Huerga discusses the relative dimensions of the capacitor plates. Proportions of features in drawings are not evidence of actual proportions when the drawings are not to scale.

Hockerson-Halberstadt, Inc. v. Avia Group Intel. 55 USPQ 2d 1487, 1491 (Fed. Cir. 2002) (“It is well established that patent drawings do not define the precise proportions of the elements and may not be relied upon to show particular sizes if the specification is completely silent on the issue”). The specification in De La Huerga does not mention the relative sizes of the capacitor plates. In fact the only mention of the size or shape of the capacitor plates is as follows: “In Fig. 34 plates 358 and 360 are shown in trapezoidal form only for illustrative purposes so that each can be easily distinguished from the other and it should be understood that plates of any shape that provide sufficient overlap may be employed.” From that statement it is clear that De La Huerga does not teach a particular size or shape and that relative size or shape is unimportant to De La Huerga. Further, De La Huerga does not even discuss the size of the capacitor plates. Elements 106 and 108 in Fig. 2 are not even capacitor plates, they are merely ends of the bracelet. There is no capacitor structure recited in either 106 or 108 and no discussion of the relative size or shape of those ends.

The one time that the De La Huerga specification does mention relative size “or in this case distance” is in comparing the distance of one coupling element 1317 from the end of the strap (L1) versus the length of the other coupling element 1315 (L2). (See Fig. 17; paragraphs 161-162). However, L1 and L2 do not both represent the length of capacitor plates. As described in De La Huerga, L1 represents the distance of one coupling element 1317 from the end of the strap 1108. Such discussion does not teach the length of a capacitor plate, rather it teaches the relative position of the coupling element on the bracelet. L2 represents the length of an exposed contactor coupling element 1315. Clearly, L1 and L2 do not represent the relative lengths of the coupling elements or capacitor plates. L1 does not even represent a dimension of a coupling element, but rather the placement of a coupling element on the bracelet.

Further, the Office Action states that L2 has a greater length than L1 apparently relying upon the depiction of the various elements in Fig. 17. However, as stated above patent drawings do not define the precise proportions of the elements and may not be relied upon to show particular sizes if the specification is completely silent on the

issue. Not only is the specification silent on the issue of the length of L2 being greater than the length of L1, the specification states the exact opposite, that L1 is slightly longer than L2. (Paragraph 161, last sentence). Regardless of this statement of relative length, it is clear that L1 and L2 do not both represent relative dimensions of coupling elements or capacitor plates and therefore do not support the basis of rejection set forth in the Office Action.

In rejecting claims 11, 28 and 45 the Office Action states that De La Huerga, in Fig. 17, shows capacitive plates L2/1315 and L1/1317 having the same width (paragraphs 161-163) where Fig. 34 shows the width of the capacitive plates 358 and 360 are relatively the same (paragraphs 228-229). The Office Action goes on to state that it would have been obvious to modify the width/length/size of the capacitive plates in order to acquire a desired/relative dimension, citing MPEP §2144.04 IV.

Initially the Office Action misidentifies elements L2 and L1 from the De La Huerga patent as capacitive plates. As discussed above L2 represents the length of an exposed contact and L1 represents the space between the end of the wristband and a second exposed contact. In addition, as discussed above, where a specification is silent on the issue patent drawings cannot be relied upon to show specific or relative sizes and/or shapes of elements. Further, regarding elements 358 and 360 the De La Huerga patent specifically states that such elements are “shown in trapezoidal form only for illustrative purposes so that each can be easily distinguished from the other and it should be understood that plates of any shape that provide sufficient overlap may be employed.” (Paragraph 228). The size or shape of elements 358 and 360 is unimportant.

The Office Action then misapplies the teachings of MPEP §2144.04 IV. Specifically that section and the cases cited therein deal with patent claims that merely scale up or down the size or proportion of a prior claimed process or apparatus. Cases cited in the MPEP present factual situations as follows:

In re Rose 105 USPQ 237 (CCPA 1955) - Court affirmed rejection of patent claims directed to bundles of lumber packed in a certain way where the only difference

from the prior art was that the claimed inventive bundle of lumber is of an appreciable size and weight with respect to the prior art bundles.

In re Reinhart, 189 USPQ 143 (CCPA 1976) - In considering a claim to a process that represented a previously patented process albeit at a commercial scale, the court stated that "The mere scaling up of a prior art process capable of being scaled up ... would not establish patentability in a claim to an old process so scaled."

Gardener v. TEC Systems, Inc., 220 USPQ 777 (Fed. Cir. 1984) - The court found a claimed device unpatentable where the only difference between the device and the prior art was the recitation of relative dimensions of the claimed device that did not perform differently than the prior art device.

In contrast, the present claims do not merely scale up or scale down a prior art device but recite relative dimensions of two features within the claimed device. These claims are patentably distinct because they do not represent a mere scaling up or scaling down of that which is claimed in the prior art. The current claims recite a specific structure that performs differently from the prior art devices. Specifically, the limitation requiring one of said coupling elements to have a predetermined area and the other of said coupling elements having a length greater than the length of said one coupling element creates a structure whereby the coupling elements are almost assuredly overlapping to ensure a secure electrical connection. The prior art merely requires that the capacitive plates be of any shape to provide sufficient overlap. The limitations set forth in the current claims are not obvious over the cited prior art and MPEP §2144.04 IV fails to support the rejection.

For the reasons set forth above the combination of De La Huerga and Harilela fails to render claim 23 obvious. As set forth above, De La Huerga fails to teach the limitation requiring the relative sizes and shapes of the coupling elements. Harilela fails to supply this missing teaching as well.

Applicants submit that the claims as presented comprise allowable subject matter. Accordingly claims 1-9, 11-26, 28-43 and 45-55 are in condition for allowance, notice of which is respectfully requested.

Respectfully submitted,

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